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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/534,638

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Tanichi Ando

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FOLEY AND LARDNER LLP

SUITE 500

3000 K STREET NW

WASHINGTON, DC 20007

EXAMINER

JAKOVAC, RYAN J

ART UNIT

PAPER NUMBER

2445

MAIL DATE

DELIVERY MODE

04/29/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,638

Applicant(s)

ANDO ET AL.

Examiner

RYAN J. JAKOVAC

Art Unit

2445

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4, 6-10, 12, 13, 16, 18 and 20-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 6-10, 12, 13, 16, 18 and 20-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 4, 16, and 18 are rejected under 35 U.S.C. 101 since the claimed invention is directed to non-statutory subject matter.

3. Claim 1 is directed towards an information delivery system comprising "an information reproduction mode changer", and a first and second "communication device". These elements are considered to be software or a program per se, which is not one of the categories of statutory subject matter.

4. Regarding claims 16, and 18, these claims are directed towards an information acquisition device and information delivery server respectively. These elements are considered to be software or a program per se, which is not one of the categories of statutory subject matter.

5. Claim 20 is rejected under 35 U.S.C. 101; this claim cites a method but fails to (1) positively recite the statutory class to which they are tied to, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. The methods relate to the enabling of communication between communication devices and an information center, however, these are interpreted as being embodied in software and thus do not belong to any statutory class.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 18, 20, 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite the terms "determination information transmitter" which are not present in the specification. Claim 1 recites the term "selecting result transmitter" which is not present in the specification. Claim 23 recites the term "information reproduction mode changer" which is not present in the specification.

8. Claim 23 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 23 recites "the information reproduction mode changer is capable of changing content or reproduction order of the content items in the information reproduction device, which content and content order are determined when the content item is created, according to one or a plurality of: event information produced by operation by a user". This limitation was not described in the specification in order to enable

one skilled in the art to be able to use the information reproduction mode changer as required by the invention without undue experimentation.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites in part "...a determining module for determining a time taken for the mobile body to reach a communication area for a nearest DSRC terminal device, as a level of attribute information of target information, which is selected by a user of the mobile body and is to be delivered from the information delivery center..." It is unclear what is selected by a user of the mobile body. It is further unclear what function or relation a time taken for the mobile body is represented by a "level of attribute information" and how this level of attribute information relates to the "target information." The scope of the claim is therefore rendered indefinite.

11. Claims 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites in part "...which content and content order are determined when the content item is created, according to one or a plurality of: event information produced by operation by a user..." This limitation is inherently unclear since it is not in proper idiomatic English.

12. Claim 25 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims recite an "accounting function" and "accounting operations". It is unclear how and/or by what elements these functions are performed.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 4, 6-10, 12, 13, 16, 18, 20-30 are rejected under 35 U.S.C. 103(a) as being anticipated by US 2002/0164998 to Younis in view of US 6,429,812 to Hoffberg and further in view of US 2002/0032024 to Namba et al (hereinafter Namba).

Regarding claims 4, 9-10, 13, 16, 18, 20-23, Younis teaches an information delivery system in which an information reproduction device reproduces information delivered from an information delivery center, the information delivery system comprising:

an information reproduction mode changer for changing reproduction mode for the information based on circumstances of information reproduction in the information reproduction

device (Younis, abstract, the mobile device receives information through interacting with the application server. [0015], user interacts with voice-activated menu.);

Younis does not expressly disclose a first communication device for enabling communication between a mobile body and the information delivery center using DSRC communication, the mobile body including the information reproduction device and residing in a first communication area. However, Hoffberg discloses a first communication device for enabling communication between a mobile body and the information delivery center using DSRC communication (Hoffman, col. 21, line 9-67, DSRC systems provide communications, propagation of event information to remote database. See also, fig. 1, mobile communications device. See also col. 24:30-65, communications functions integrated into device.).

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to combine a first communication device for enabling communication between a mobile body and the information delivery center using DSRC communication, the mobile body including the information reproduction device and residing in a first communication area as taught by Hoffman with the system of Younis in order to provide communications between vehicles and roadside systems (Hoffman, col. 21, line 9-30.).

Younis discloses a second communication device for enabling communication between the mobile body and the information delivery center when the mobile body resides in a second communication area which is larger than the first communication area, the second communication device carrying out communication with a lower speed than the first communication device (Younis, [0008-0017], wireless communications system and network utilizing GPS functionality on a wireless devise.),

wherein: the information reproduction mode changer includes:

a determining module for determining a time taken for the mobile body to reach a communication area for a nearest DSRC terminal device (Younis, [0029], time difference of signals sent between wireless device and base station is calculated. See also [0044].), as a level of attribute information of target information, which is selected by a user of the mobile body and is to be delivered from the information delivery center (Younis, [0044], driver selects route and destination.);

a determination information transmitter for transmitting determination information, which is a determination result of the determining module, to the mobile body via either the first communications device or the second communications device (Younis, [0044], as a result of user input, updated instructions are downloaded by the application server which are subsequently used on the wireless device.);

The combination of Younis and Hoffberg do not expressly disclose a selecting result transmitter for transmitting the information delivery center a selecting result made by the user as to which of the first communications device and the second communication device is used for obtaining the target information, which result is made based on the determination information transmitted from the determination information transmitter; and selecting module for selecting either the first communication device or the second communication device to be used for delivery of the target information to the information reproduction device, based on the selecting result transmitted from the selecting result transmitter wherein the determination information transmitter transmits the determination information by the second communication device; and wherein a selecting result is transmitted from a mobile body to the information delivery center,

which selecting result is made by a user as to which one of the first communication device or the second communication device is to be used, based on a determination result transmitted from the information delivery center to the mobile body via the determination information transmitter, and wherein the selecting module of the information delivery center determines which one of the first communication device and the second communication device is to be used, based on the selecting result.

However, Namba discloses a selecting result transmitter for transmitting the information delivery center a selecting result made by the user as to which of the first communications device and the second communication device is used for obtaining the target information (Namba, [0010].), which result is made based on the determination information transmitted from the determination information transmitter; and selecting module for selecting either the first communication device or the second communication device to be used for delivery of the target information to the information reproduction device, based on the selecting result transmitted from the selecting result transmitter wherein the determination information transmitter transmits the determination information by the second communication device (Namba, [0010], based on the criteria selected, a communication device is selected.); and wherein a selecting result is transmitted from a mobile body to the information delivery center, which selecting result is made by a user as to which one of the first communication device or the second communication device is to be used, based on a determination result transmitted from the information delivery center to the mobile body via the determination information transmitter, and wherein the selecting module of the information delivery center determines which one of the first communication device and the second communication device is to be used, based on the selecting result (Namba, [0010], the

first communications device is adapted to use a plurality of communications systems. The device transmits a request for downloading data and receives a response based on the request. Based on the criteria of the response a communications device is selected.).

It would have been obvious to combine the teachings of Namba with the combination of Younis and Hoffberg in order to be able to select a communication system based on the attributes of the data, for example to select a high speed or low speed communication system (Namba, [0007-0008, 0010-0011].).

Regarding claims 6-8, the combination of Younis, Hoffberg, and Namba teach the system of claim 4. Regarding wherein the attribute information includes an urgency of transmission of the target information, a data amount of the target information, a time needed for transmission of the target information via either the first communication device or the second communication device. These differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the nonfunctional descriptive material with the claimed invention because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the descriptive material does not patentably distinguish the claimed invention.

Regarding claim 12, the combination of Younis, Hoffberg, and Namba teach the system of claim 4 the selecting module means selects is configured to select the first communication device-means to be used for transmission of the target information to the mobile body, and to reserve a DSRC terminal device used for the transmission of the target information before the transmission (Hoffberg, col. 21:10-65, col. 24:25-50, propagation of event information, central repository of event data, event information exchanged wirelessly with base unit or service station.).

Regarding claims 24-25, 27-30, the combination of Younis, Hoffberg, and Namba teaches the information delivery system as set forth in claim 23, wherein: the content items are delivered in such a manner that the plurality of content item files are accumulated in an upper directory of a tree-structure including a plurality of lower directories, allowing a user of the information reproduction device to select a target upper directory or a lower directory so that all content item data in the target upper directory or the lower directory thus selected are downloaded as one group (Younis, [0016], server activates a menu which allows the user to select from a set of service and information options. See also [0044].).

Regarding claim 26, the combination of Younis, Hoffberg, and Namba teaches the information delivery system as set forth in claim 23, wherein: each of the plurality of content item files previously includes a guide content item for showing details or usage instruction of the

content item, the guide content item is reproduced whenever required by a switching operation by the user (Hoffberg, col. 7:10-67, voice input to menu.).

Conclusion

15. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN J. JAKOVAC whose telephone number is (571)270-5003. The examiner can normally be reached on Monday through Friday, 7:30 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RJ/
/Larry D Donaghue/
Primary Examiner, Art Unit 2454